

ESTTA Tracking number: **ESTTA652659**

Filing date: **01/28/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	NextgenID, Inc.
Granted to Date of previous extension	01/28/2015
Address	10226 San Pedro, Ste. 100 San Antonio, TX 78216 UNITED STATES

Attorney information	David L. May Nixon Peabody LLP 401 Ninth Street NW, Suite 900 Washington, DC 20004 UNITED STATES nptm@nixonpeabody.com, was.managing.clerk@nixonpeabody.com, dmay@nixonpeabody.com, jmolino@nixonpeabody.com Phone:202.585.8000
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### Applicant Information

Application No	86234336	Publication date	09/30/2014
Opposition Filing Date	01/28/2015	Opposition Period Ends	01/28/2015
Applicant	NexID Biometrics LLC 65 Main St, Box 2, Suite 2203 Potsdam, NY 13676 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 2012/10/30 First Use In Commerce: 2012/10/30 All goods and services in the class are opposed, namely: Computer software for processing digital images
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2892487	Application Date	08/07/2002
Registration Date	10/12/2004	Foreign Priority Date	NONE
Word Mark	NEXTGENID		

Design Mark	<b>NEXTGENID</b>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2001/08/01 First Use In Commerce: 2001/08/01 Security and access and exit control devices for internal facilities and buildings, namely, electronically operated reader pads for biometric recognition, and motion sensitive security arrays; computer software for use in monitoring and operating security systems and access and exit control devices in internal facilities and buildings; computer software, hardware, and peripherals for biometric recognition and analysis

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	NEXTGENID		
Goods/Services	a wide variety of goods and services in the biometrics field, including computer software for processing digital images		

Attachments	76438838#TMSN.png( bytes ) NEXTGENID Reg.pdf(32775 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JSM/
Name	Jeffrey S. Molinoff
Date	01/28/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Application Serial No. 86/234,336  
Mark: NEXID BIOMETRICS & Design  
Published in the *Official Gazette*: September 30, 2014

NEXTGENID, INC.	)	
	)	
	)	
v.	)	Opposition No. _____
	)	
NEXID BIOMETRICS LLC,	)	
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

NEXTGENID, INC., a Delaware corporation with its principal place of business at 10226 San Pedro, Ste. 100, San Antonio, Texas 78216 , (hereinafter “Opposer”), believing it will be damaged by registration of the above-captioned application, hereby opposes registration of the mark NEXID BIOMETRICS & Design shown in Application Serial No. 86/234,336, filed March 27, 2014, under the Trademark Act of 1946, in the name of NexID Biometrics LLC, a New York limited liability company with an address of record at 65 Main St, Box 2, Suite 2203, Potsdam, New York 13676 (hereinafter “Applicant”), published for opposition in the *Official Gazette* of September 30, 2014.

The grounds of Opposition are as follows:

1. Opposer is the owner of incontestable U.S. Registration No. 2,892,487 (the “ ’487 Registration”), for the mark NEXTGENID, for use in connection with, *inter alia*, *Security and access and exit control devices for internal facilities and buildings, namely, electronically*

*operated reader pads for biometric recognition, and motion sensitive security arrays; computer software for use in monitoring and operating security systems and access and exit control devices in internal facilities and buildings; computer software, hardware, and peripherals for biometric recognition and analysis*, in Class 9.

2. Opposer claims common law rights in the NEXTGENID Mark for use with *a wide variety of goods and services in the biometrics field, including computer software for processing digital images*.

3. The marks set forth in the '487 Registration and in Paragraph 2 above shall be referred to herein collectively as the "NEXTGENID Marks." A copy of the Trademark Status & Document Retrieval ("TSDR") system record for the foregoing registration is attached hereto as Exhibit A.

4. Opposer has long used the NEXTGENID Marks in commerce in connection with at least the goods and services set forth in the '487 Registration. As a result of Opposer's longstanding use of and investment of resources in the NEXTGENID Marks, Opposer has developed significant goodwill in the NEXTGENID Marks.

5. On March 27, 2014, Applicant filed U.S. Application Serial No. 86/234,336 (the "Opposed Application"), pursuant to Trademark Act § 1(a), for the mark NEXID BIOMETRICS & Design, for use in connection with the goods, *computer software for processing digital images*, in Class 9, claiming use since October 30, 2012 ("the Opposed Mark").

6. As described on its website, <http://nexidbiometrics.com/>, applicant's goods are for use in biometrics. The website specifically states:

**What We Do** – Utilizing patented software technology, we provide our customers with a systems-level approach to enhancing biometric solutions utilizing the latest biometrics innovations for liveness detection and spoof mitigation.

**Products** – Our flagship product is a software-based, fingerprint liveness detection application that exploits raw image characteristics between real fingers and spoof attacks, thereby instilling confidence into our customers’ biometric authentication solutions.

7. Opposer has established prior rights in the NEXTGENID Marks in connection with at least the goods and services set forth within its aforementioned registration prior to any date upon which Applicant can rely for use of the mark set forth in the Opposed Application.

8. Through its long and continuous use of the NEXTGENID Marks, Opposer has expended significant revenue and resources in the marketing and sale of a wide range of computer hardware, computer software, computer peripherals, and other goods associated with biometrics, and, through these efforts, has established valuable consumer recognition and goodwill therein.

9. Applicant’s proposed use and registration of the mark set forth in the Opposed Application will create a likelihood of confusion, mistake and/or deception among consumers, within the meaning of Trademark Act § 2(d), all to the detriment of Opposer.

WHEREFORE, Opposer believes that it has been damaged and will continue to be damaged by virtue of Applicant’s attempted registration of Applicant’s Trademark Application No. 86/234,336 and requests that said application be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed David L. May, of the law firm of Nixon Peabody LLP, a member of the Bar of the District of Columbia, and Jeffrey S. Molinoff, also a member of the District of Columbia Bar, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

David L. May  
Nixon Peabody LLP  
401 9<sup>th</sup> Street NW  
Suite 900  
Washington, DC 20004

Email: [was.managing.clerk@nixonpeabody.com](mailto:was.managing.clerk@nixonpeabody.com)  
[nptm@nixonpeabody.com](mailto:nptm@nixonpeabody.com)

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 50-2686.

Dated: January 28, 2015

Respectfully submitted,

**NIXON PEABODY LLP**

by: \_\_\_\_\_/DLM/\_\_\_\_\_

David L. May  
Jeffrey S. Molinoff

401 9<sup>th</sup> Street, N.W., Suite 900  
Washington, D.C. 20004-2128  
202-585-8000 (Phone)  
[was.managing.clerk@nixonpeabody.com](mailto:was.managing.clerk@nixonpeabody.com)  
*Counsel for Opposer*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Notice of Opposition was served on Applicant's attorney this 28<sup>th</sup> day of January, 2015, by sending same, via first class mail, postage prepaid and via-email, to:

Cynthia J. Lee  
Thomas | Horstemeyer LLP  
400 Interstate North Parkway SE  
Suite 1500  
Atlanta, Georgia 30339

/JSM/  
\_\_\_\_\_  
Jeffrey S. Molinoff

4845-5992-6561.1

# EXHIBIT A



**Generated on:** This page was generated by TSDR on 2015-01-28 12:40:42 EST

**Mark:** NEXTGENID

NEXTGENID

**US Serial Number:** 76438838

**Application Filing Date:** Aug. 07, 2002

**US Registration Number:** 2892487

**Registration Date:** Oct. 12, 2004

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Oct. 27, 2014

**Publication Date:** Feb. 17, 2004

## Mark Information

**Mark Literal Elements:** NEXTGENID

**Standard Character Claim:** No

**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Security and access and exit control devices for internal facilities and buildings, namely, electronically operated reader pads for biometric recognition, and motion sensitive security arrays; computer software for use in monitoring and operating security systems and access and exit control devices in internal facilities and buildings; computer software, hardware, and peripherals for biometric recognition and analysis

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Aug. 01, 2001

**Use in Commerce:** Aug. 01, 2001

## Basis Information (Case Level)

**Filed Use:** Yes

**Currently Use:** Yes

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** NEXTGENID, INC.

**Owner Address:** 10226 San Pedro Ste. 100  
San Antonio, TEXAS 78216  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where  
Organized:** DELAWARE

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** David L. May

**Docket Number:** 746815-6

**Attorney Primary Email  
Address:** [nptm@nixonpeabody.com](mailto:nptm@nixonpeabody.com)

**Attorney Email  
Authorized:** Yes

### Correspondent

**Correspondent:** David L. May

**Name/Address:** NIXON PEABODY LLP  
401 9TH STREET, NW., SUITE 900  
Alexandria, VIRGINIA 20004  
UNITED STATES

**Phone:** 202-585-8000

**Fax:** 202-585-8080

**Correspondent e-mail:** [nptm@nixonpeabody.com](mailto:nptm@nixonpeabody.com)

**Correspondent e-mail** Yes  
**Authorized:**

**Domestic Representative - Not Found**

## Prosecution History

Date	Description	Proceeding Number
Oct. 27, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Oct. 27, 2014	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	69471
Oct. 27, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	69471
Oct. 24, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	69471
Oct. 10, 2014	TEAS SECTION 8 & 9 RECEIVED	
Nov. 02, 2011	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Nov. 02, 2011	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Jun. 14, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77315
Jun. 14, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
May 25, 2010	TEAS SECTION 8 & 15 RECEIVED	
Mar. 03, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Sep. 26, 2009	REVIEW OF CORRESPONDENCE COMPLETE	76293
Apr. 26, 2006	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
May 19, 2005	PAPER RECEIVED	
Mar. 24, 2005	CERTIFICATE OF CORRECTION ISSUED	
Nov. 03, 2004	SEC 7 REQUEST FILED	
Nov. 03, 2004	PAPER RECEIVED	
Oct. 12, 2004	REGISTERED-PRINCIPAL REGISTER	
Aug. 18, 2004	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Mar. 04, 2004	EXTENSION OF TIME TO OPPOSE RECEIVED	
Feb. 17, 2004	PUBLISHED FOR OPPOSITION	
Jan. 28, 2004	NOTICE OF PUBLICATION	
Dec. 13, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 01, 2003	ASSIGNED TO EXAMINER	76464
Nov. 25, 2003	PETITION TO REVIVE-GRANTED	66600
Aug. 05, 2003	PETITION TO REVIVE-RECEIVED	
Aug. 26, 2003	ABANDONMENT - FAILURE TO RESPOND OR LATE RESPONSE	76931
Aug. 05, 2003	PAPER RECEIVED	
Jan. 30, 2003	NON-FINAL ACTION MAILED	
Dec. 13, 2002	ASSIGNED TO EXAMINER	76931

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Oct. 12, 2014

**Change in Registration:** Yes

**Correction made to Registration:** In the statement, Column 1, line 1, "NEXTGENLD" should be deleted, and, NEXTGENID should be inserted.

## TM Staff and Location Information

## TM Staff Information - None

## File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Oct. 27, 2014

## Assignment Abstract Of Title Information

### Summary

Total Assignments: 2

Registrant: NEXTGENID, LTD.

#### Assignment 1 of 2

Conveyance: MERGER

Reel/Frame: [3295/0208](#)

Pages: 3

Date Recorded: Apr. 24, 2006

Supporting Documents: [assignment-tm-3295-0208.pdf](#)

#### Assignor

Name: [NEXTGENID, LTD.](#)

Execution Date: Aug. 03, 2005

Legal Entity Type: LIMITED PARTNERSHIP

State or Country Where  
Organized: TEXAS

#### Assignee

Name: [NGID ACQUISITION CORPORATION](#)

Legal Entity Type: CORPORATION

State or Country Where  
Organized: TEXASAddress: 2810 N. FLORES STREET  
SAN ANTONIO, TEXAS 78212

#### Correspondent

Correspondent Name: DAVID L. MAY

Correspondent Address: 401 9TH STREET, N.W.  
SUITE 900  
WASHINGTON, DC 20004-2128

#### Domestic Representative - Not Found

#### Assignment 2 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4157/0537](#)

Pages: 3

Date Recorded: Feb. 26, 2010

Supporting Documents: [assignment-tm-4157-0537.pdf](#)

#### Assignor

Name: [NGID ACQUISITION CORPORATION](#)

Execution Date: Feb. 25, 2010

Legal Entity Type: CORPORATION

State or Country Where  
Organized: TEXAS

#### Assignee

Name: [NEXTGENID, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where  
Organized: DELAWAREAddress: 2810 N. FLORES STREET  
SAN ANTONIO, TEXAS 78212

#### Correspondent

Correspondent Name: DAVID L. MAY, NIXON PEABODY LLP

Correspondent Address: 401 9TH STREET, N.W.  
SUITE 900  
WASHINGTON, DC 20004

#### Domestic Representative - Not Found

## Proceedings

### Summary

Number of Proceedings: 1

#### Type of Proceeding: Extension of Time

Proceeding Number: [76438838](#)

Filing Date: Mar 04, 2004

Status: Terminated

Status Date: Jul 16, 2004

Interlocutory Attorney:

#### Defendant

**Name:** NextgenID, Ltd.

**Correspondent Address:** JEFFREY L. COSTELLIA  
NIXON PEABODY LLP  
8180 GREENSBORO DRIVE, SUITE 800  
MCLEAN VA , 22102  
UNITED STATES

Associated marks			
Mark	Application Status	Serial Number	Registration Number
NEXTGENID	Renewed	<a href="#">76438838</a>	<a href="#">2892487</a>

**Potential Opposer(s)**

**Name:** Nextel Communications, Inc.

**Correspondent Address:** Edward W. Gray, Jr.  
Morrison & Foerster LLP  
2000 Pennsylvania Ave, NW Suite 5500  
Washington DC , 20006  
UNITED STATES

**Correspondent e-mail:** [abishop@mofo.com](mailto:abishop@mofo.com)

Prosecution History			
Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Mar 04, 2004	
2	EXTENSION OF TIME GRANTED	Mar 04, 2004	